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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ALEXANDER Y.C. CHENG

Appeal 2011-007361
Application 11/045,167
Technology Center 3600

Before CHARLES N. GREENHUT, PATRICK R. SCANLON, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Alexander Y.C. Cheng (“Appellant”) requests rehearing under 37 C.F.R. § 41.52 of our decision mailed July 17, 2013 (“Decision”), in which we affirmed the Examiner’s decision rejecting claims 3-13. Appellant filed the Request for Rehearing (“Request”) on September 17, 2013.

A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board in rendering the original decision. 37 C.F.R. § 41.52. Appellant’s Request is primarily directed to independent claim 3, which was rejected under 35 U.S.C. § 103(a) as being unpatentable over Impink (US 5,251,242, iss. Oct. 5, 1993) and Applicant’s Admission of Prior Art (“AAPA”). Appellant does not contend that the Board misapprehended or overlooked any points specifically relating to the merits of the rejections of claims 4-13.

OPINION

I.

The focus of the Request relates to our statement in the Decision that “[w]e agree with Appellant that in the context of how the phrase is used in Impink, ‘end to end’ means that the detectors 30-40 are arranged linearly but not necessarily over the full length of the fuel assembly.” Decision 5. Specifically, Appellant asserts:

[c]onsistent with this Board finding, the Examiner cannot be correct in stating on page 4 of the Examiner’s Answer that ‘end to end within a reactor assembly’ in Impink means, in other words (*i.e.*), ‘over the height of the core.’ Accordingly, the Board, has implicitly concluded that the Examiner has erred as to the ‘scope and content’ of the prior art reference Impink.

Request 6. This argument is not persuasive because, as stated on pages 5-6 of the Decision, we did not determine the Examiner erred in finding Impink discloses that the stack of platinum detectors 30-40 extend over the full height of the core or fuel assembly. Rather, we found that the Examiner's interpretation of "end to end" was erroneous.

Contrary to Appellant's assertion, this misinterpretation is not dispositive of whether Impink discloses that the stack of platinum detectors 30-40 extends over the full height of the core because the Examiner's reading of "end to end" was not the sole basis for the finding. As we noted on page 4 of the Decision, the Examiner also relied on the passage at column 1, lines 5-23 of Impink to support of the finding. Regarding this passage, we found that "Impink discloses that a vanadium detector extends 'at least over the full length of the stack of platinum segments *and* could extend the height of the core.' Impink, col. 1, ll. 19-21 (emphasis added)." Decision 5. We also found that "Figure 7 of Impink shows the stack of platinum detectors 30-40 to be co-extensive with the vanadium detector 82." *Id.* at 6; *see also* Impink, col. 1, ll. 19-23 (describing that the vanadium detector could extend the height of the core "along with a platinum detector of equal length"). We thus determined "that Impink would suggest to one of ordinary skill in the art that the stack of platinum detectors 30-40 could extend over the full height of the core." *Id.*

In other words, we found that Impink implicitly discloses this feature. *See* MPEP § 2144.01 ("[I]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.") (quoting *In re Preda*, 401 F.2d 825, 826

(CCPA 1968)). Because Impink discloses that the vanadium detector can extend over the height of the core and the stack of platinum detectors 30-40 can be equal in length to the vanadium detector, one skilled in the art would reasonably be expected to draw the inference that Impink discloses an embodiment in which the stack of platinum detectors 30-40 extends over the full height of the core.

Accordingly, we disagree with Appellant's contention that the Examiner's rejections of claims 3-13 should be reversed.

II.

Appellant also asserts that we mischaracterized several aspects of the Examiner's rejection and Appellant's Briefs and requests that these items be corrected. Request 7-8.

First, Appellant argues that, contrary to our position, the Examiner has not made a finding that Impink discloses platinum detectors that "extend 'end-to-end within a reactor assembly' and 'over the height of the core.'" *Id.* at 7 (citing Decision 4). Instead, Appellant contends the Examiner "found that 'end to end within the reactor assembly' in Impink *means*, in other words ("*i.e.*"), 'over the height of the core.'" *Id.* We disagree that our statement on page 4 of the Decision mischaracterized the Examiner's finding. The Examiner points to Impink's Abstract as disclosing that the platinum detectors extend "end-to-end within a reactor assembly" and to the passage at column 1, lines 5-23 of Impink as disclosing that the platinum detectors extend "over the height of the core." Ans. 4. Even though the Examiner uses the term "*i.e.*" to join the two disclosures in Impink, the fact remains that the Examiner cites these two different disclosures and is not relying solely on the misinterpretation of "end to end" as discussed *supra*.

Second, Appellant questions our statement on page 5 of the Decision that “Appellant also argues that Impink’s description of a detector that could extend the height of the core necessarily means the total length of the segmented platinum detectors 30-40 is less than the height of the core,” asserting that no such reasoning can be found in pages 7-8 of Appellant’s Appeal Brief. *Id.* Appellant’s third allegation of error is that “the Board appears to misquote and/or present an incomplete description of Appellant’s brief on page 5, lines 9-14 of the Decision” and this statement in the Decision is “internally inconsistent.” *Id.* at 8. The second cited statement on page 5 of the Decision reads:

Specifically, Appellant argues that because Impink discloses that a single vanadium detector extends “at least over the full length of the stack of platinum segments and could extend the height of the core,” the vanadium detector “is longer than the overall length of the stack of platinum detectors, which, thus, must be less than the height of core.”

Decision 5.

We disagree that either of these statements mischaracterizes Appellant’s briefs. Appellant’s Appeal Brief states “[t]he disclosure of Impink at column 1, lines 5 to 23, would also be understood by one of ordinary skill in the art to teach that the total length of the segmented platinum detectors 30 to 40 is less than the height of the core.” App. Br. 7-8. Appellant’s Appeal Brief also states:

Thus, *Impink discloses* that, where *a single vanadium detector* is used in conjunction with the disclosed end to end stack of platinum detectors illustrated in Figure 3 in the manner illustrated in Figure 7, the vanadium detector has a length that extends at least over the full length of the stack of platinum segments, and can also extend beyond that length to the height of the core. It is clear from that recitation of “*at least over the*

full length of the stack of platinum segments and could extend the height of the core” that a height of at least over the full length of the stack is less than a further extension to the height of the core. Therefore, the full length of the stack of platinum segments is less than the height of the core, and Impink does not disclose or suggest that the overall length of the stack of platinum detectors is equal to the height of the core. Instead, Impink teaches that a vanadium detector that extends to the height of the core is longer than the overall length of the stack of platinum detectors, which, thus, must be less than the height of core.

Id. at 8 (emphases added). These passages clearly support both of the statements from page 5 of the Decision.

Fourth, regarding our statement that “Appellant’s basis for asserting the stack of platinum segments *must* be less than the height of the core is flawed” from page 6 of the Decision, Appellant asserts “the Board has not accurately set forth a portion of Appellant’s arguments that are flawed.” Request 8. However, the statement questioned by Appellant is taken from the last sentence of the paragraph bridging pages 5 and 6 of the Decision. That paragraph, in its entirety, sets forth the reasons why Appellant’s assertion that the stack of platinum segments must be less than the height of the core is flawed.

Fifth, Appellant argues that our statement that we “agree with the Examiner that Impink would suggest to one of ordinary skill in the art that the stack of platinum detectors 30-40 could extend over the full height of the core” from page 6 of the Decision “is inconsistent with the Board’s earlier statement that such a limitation was found to be ‘disclosed’ by the Examiner.” *Id.* We disagree because the Decision does not indicate that we found any limitation to have been disclosed *by the Examiner*. To the extent

Appellant meant to refer to our statement from page 4 of the Decision that the “Examiner finds that Impink discloses a method of measuring neutron flux including, *inter alia*, the step of providing at least three platinum detectors 30-40 that extend ‘end-to-end within a reactor assembly’ and ‘over the height of the core,’” this statement is not inconsistent with the above-quoted statement from page 6 of the Decision.

III.

Appellant argues that the rejection of claim 3 should be designated as a new ground of rejection because the finding that Impink would suggest to one of ordinary skill in the art that the stack of platinum detectors 30-40 could extend over the full height of the core “appears to be based on inherency or obviousness.” *Id.* at 8-9.

As discussed *supra*, the Examiner relied in part on the passage at column 1, lines 5-23 of Impink in rejecting claim 3, and we found that this passage shows that Impink implicitly discloses that the stack of platinum detectors 30-40 extends over the full height of the core. Contrary to Appellant’s argument, our finding was not based on inherency.

However, although the Examiner cited column 1, lines 5-23 of Impink in rejecting claim 3, the Examiner did not specify the details of Impink’s disclosure that we have relied on in finding that Impink implicitly discloses that the stack of platinum detectors 30-40 extends over the full height of the core. We have thus arguably relied on a reasoning that was not previously relied on by the Examiner and thus changes the “thrust” of the rejection. *See In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976).

Therefore, in the circumstances of this case, we exercise discretion to grant Appellant’s request to designate our affirmance of the rejection of

claim 3 as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). We also designate our affirmance of the rejections of claims 4-13, which depend from claim 3, as new grounds of rejection.

This decision on rehearing does not constitute a new decision on appeal. Nor does it turn the Decision into a new decision. Accordingly, pursuant to 37 C.F.R. § 41.52(a)(1), no request for rehearing from this decision on rehearing is permitted. Also, because Appellant did not argue persuasively in the rehearing request the merits of any rejection affirmed in the Decision, Appellant is not entitled to any further relief under 37 C.F.R. § 41.50(b)(2) once the Decision has been modified to designate the affirmance of the rejections of claims 3-13 as new grounds of rejection.

DECISION

Appellant's Request is denied with respect to the arguments that the Examiner's rejections should be reversed and the Board mischaracterized several aspects of the Examiner's rejection and Appellant's Briefs, but is granted to the extent ordered below.

ORDER

The Board's affirmance of the Examiner's rejections of claims 3-13 is designated as a new ground of rejection under 37 C.F.R. § 41.50(b). Pursuant to the applicable sections of 37 C.F.R. § 41.50(b), Appellant, WITHIN TWO MONTHS FROM THE DATE OF THIS DECISION, must exercise the following option with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter

reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

37 C.F.R. § 41.50(b) also provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

GRANTED-IN-PART; 37 C.F.R. § 41.50(b)

Mp/rvb